

REMARKS/ARGUMENTS

The rejections presented in the Office Action dated February 25, 2009 (hereinafter Office Action) have been considered. Claims 1, 3-17, and 19-32 will be pending in the application after the entry of this amendment. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

The Applicant respectfully submits that the claims as previously presented are allowable. However, in order to facilitate prosecution of the application and in a *bona fide* attempt to advance the application to allowance, the Applicant presents this response with amendment to enhance an understanding of particular aspects of the claimed invention.

The Applicant also notes that claims 1, 17, 19, 31, and 32 have been amended to remove descriptive language from its preamble, and removing this language was not related to patentability. By removing this language, claims 1, 17, 19, 31, and 32 have not been narrowed.

Claims 1-17 are rejected based on 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

The Applicant respectfully asserts that the claims as previously presented are directed to statutory subject matter. However, the Applicant has amended claims 1-17 to more explicitly describe the “computer-readable medium with instructions stored thereon...” as reading “computer-readable *storage* medium with instructions stored thereon...” The Applicant respectfully asserts that since the instructions are *stored* and the claims are describing a *storage* medium that claims 1-17 are directed to statutory subject matter. For at least these reasons, the Applicant respectfully requests withdrawal of the rejection to claims 1-17 under 35 U.S.C. §101.

Claims 1, 2, 4, 10-14, 16 and 18-32 are rejected based on 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,658,095 to Yoakum et al. (hereinafter “Yoakum”).

To anticipate a claim, the asserted reference must clearly and unequivocally disclose every element of the claimed invention. A claim is anticipated only if each and every element as set forth in the claim is found, whether expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim. All claim elements and their limitations, must be found in the prior art reference to maintain a rejection based on 35 U.S.C. §102.

The Applicant respectfully submits that the claims as previously presented are not anticipated by Yoakum. However, in order to facilitate prosecution of the application Applicant has amended claims 1 and 19 to enhance an appreciation of the Applicant's invention. Independent claims 1 and 19 have been amended to describe partial presence information as *being* less than a total of the presence information to further demonstrate that presence information is partial presence information and does not include all of the presence information communicated to a terminal. Independent claims 1, 9, 31 and 32 have also been amended with material from now canceled dependent claim 2 to enhance an appreciation of partial presence information. For example, claim 1 now states that the partial presence information is status information for presence information that has changed. Claims 19, 31, and 32 have been similarly amended. No new matter has been added.

The Applicant respectfully asserts that independent claims 1, 19, 31, and 32 are allowable over Yoakum. For example, Yoakum at least fails to describe identifying at least one presentity to which a terminal has requested presence services and configuring the presence information as partial presence information being less than a total of the presence information available for the presentity, wherein the partial presence information is status information for presence information that have changed.

The Office Action refers to column 7, lines 54-65 as describing the configuration of the presence information as partial presence information that is less than a total of the presence information available for the presentity. At this section Yoakum describes categories that are created for a subscriber using the user's presence application. The system only describes one set of presence information, corresponding to a category, being communicated by a presentity/terminal pair. Yoakum's invention never suggests that a part of the presence information requested by a terminal is transmitted in response to a status change. In Yoakum all of the presence information that is subscribed to by a terminal is retransmitted in response to a status change even if the status change only affects a very small part of the presence information. For instance, Yoakum states at column 8, lines 64-66 that "the presence information is automatically updated for each presence category, if necessary, when state changes are detected." One terminal is associated with one category of presence information as indicated in Yoakum, so the entirety of each presence document is communicated to a terminal is updated in response to a

status change in Yoakum. For at least these reasons independent claims 1, 19, 31, and 32 and their dependents are allowable over the cited reference.

Dependent claims 3-16 and 20-30 were also rejected as being anticipated by Yoakum. Each of these claims relies on Yoakum to describe all of the elements of independent claims 1 and 19 from which claims 3-16 and 20-30 ultimately depend. Applicant reasserts the arguments presented above regarding the failure of Yoakum to describe all of the elements of claims 1 and 19. While Applicant does not acquiesce with the particular rejections to these dependent claims, it is believed that these rejections are now moot in view of the remarks made in connection with independent claims 1 and 19. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from the cited references. Therefore, dependent claims 3-16 and 20-30 are also in condition for allowance.

Claims 3 and 5 are rejected based on 35 U.S.C. §103(a) as being unpatentable over Yoakum. Claims 6-8 and 15 are rejected based on 35 U.S.C. §103(a) as being unpatentable over Yoakum in view of U.S. Publication No. 2002/0129103 by Birkler (hereinafter “Birkler”).

Each of these rejections relies on Yoakum to disclose all of the elements of independent claim 1 from which claims 3, 5, 6-8 and 15 depend. Applicant reasserts the arguments presented above regarding the failure of Yoakum to describe all of the elements of claim 1. While Applicant does not acquiesce with the particular rejections to these dependent claims, it is believed that these rejections are now moot in view of the remarks made in connection with independent claim 1. Birkler was not relied upon to remedy the deficiencies of Yoakum regarding claim 1. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from the cited references. Therefore, dependent claims 3, 5, 6-8, and 15 are also in condition for allowance.

The Applicant notes the conditional allowability of claim 17 over the prior art of record. The Applicant thanks the Examiner for the indication of allowability regarding independent claim 17. The Applicant respectfully asserts that in view of the comments made above with regard to the 35 U.S.C. §101 rejection that this rejection is now moot and independent claim 17 is in condition for allowance.

The Applicant also notes the conditional allowability of claim 9. Claim 9 was objected to as being dependent upon a rejected base claim, but it is indicated in the Office action that claim 9 would be allowable if written in independent form and is also subject to the 35 U.S.C. §101 rejection. The Applicant respectfully submits that the remarks provided herein establish the allowability of independent claim 1, from which 9 is dependent. Therefore, it is believed that claim 9 is in condition for allowance.

It is to be understood that Applicant does not acquiesce to Examiner's characterization of the asserted art or Applicant's claimed subject matter, nor of the Examiner's application of the asserted art or combinations thereof to Applicant's claimed subject matter. Moreover, Applicant does not acquiesce to any explicit or implicit statements or conclusions by the Examiner concerning what would have been obvious to one of ordinary skill in the art, obvious design choices, alternative equivalent arrangements, common knowledge at the time of Applicant's invention, officially noticed facts, and the like. Applicant respectfully submits that a detailed discussion of each of the Examiner's rejections beyond that provided above is not necessary, in view of the clear absence of teaching and suggestion of various features recited in Applicant's pending claims and lack of motivation to combine reference teachings. Applicant, however, reserves the right to address in detail the Examiner's characterizations, conclusions, and rejections in future prosecution.

Authorization is given to charge Deposit Account No. 50-3581 (NOKM.019C1) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact the undersigned attorney to discuss any issues related to this case.

Respectfully submitted,

HOLLINGSWORTH & FUNK, LLC
8009 34th Avenue South, Suite 125
Minneapolis, MN 55425
952.854.2700

Date: August 21, 2009

By: /Steven R. Funk/

Steven R. Funk
Reg. No. 37,830